

REMARKS

In the present Office Action, dated May 13, 2005, claims 1-20 are pending. All of these claims have been rejected as allegedly anticipated under 35 U.S.C. § 102(e) in view of U.S. Patent No. 6,651,132 (Traut).

As a preliminary matter, Applicants note that (1) claim 10 has been amended to add an “and” between the penultimate and last claim limitations; and (2) claim 17 has been amended for cosmetic reasons – deleting an unnecessary “and” and adding a semicolon (“;”) at the end of a limitation. The Applicants thank the Examiner for the insightful feedback, but submit that claim 1-20 are patentable in view of the following remarks.

Response to Examiner’s Response to Arguments – §102 Rejection and Declaration

Regarding the Examiner’s statement that “[t]he inventive entity for the instant application is Giles et al. and thus the Traut patent is to another” (Office Action, pp. 2-3), the MPEP is clear on this issue:

"Another" means other than applicants, *In re Land*, 368 F.2d 866, 151 USPQ 621 (CCPA 1966), in other words, a different inventive entity. The inventive entity is different if not all inventors are the same. The fact that the application and reference have one or more inventors in common is immaterial. *Ex parte DesOrmeaux*, 25 USPQ2d 2040 (Bd. Pat. App. & Inter. 1992)

MPEP § 2136.04. The Applicants acknowledge the Examiner’s conclusion.

In light of this fact, the Applicants turn the Examiner’s attention to the concept of “Attribution” explained in detail in the MPEP:

Under certain circumstances an affidavit or declaration may be submitted which attempts to attribute an activity, a reference or part of a reference to the applicant. If successful, the activity or the reference is no longer applicable. When subject matter, disclosed but not claimed in a patent application filed jointly by S and another, is claimed in a later application filed by S, the joint patent or joint patent application publication is a valid reference available as prior art under 35 U.S.C. 102(a), (e), or (f) unless overcome by affidavit or declaration under 37 CFR 1.131 showing prior invention (see MPEP § 715) or an unequivocal declaration by S under 37 CFR 1.132 that he or she conceived or invented the subject matter disclosed in the patent or published application. Disclaimer by the other patentee or other applicant of the published application should not be required but, if submitted, may be accepted by the examiner.

MPEP § 716.10. Helpfully, in the same section, the MPEP also gives the following examples, Example 1 and Example 2, that clarify what the Applicants had in mind when composing the last response, dated December 22, 2004:

Example 1: During the search the examiner finds a reference fully describing the claimed invention. The applicant is the author or patentee and it was published or patented less than one year prior to the filing date of the application. The reference cannot be used against applicant since it does not satisfy the 1-year time requirement of 35 U.S.C. 102(b).

Id. The second example is as follows, and reflects the Examiner's conclusion:

Example 2: Same facts as above [i.e. in Example 1], but the author or patentee is an entity different from applicant. Since the entities are different, the reference is prior art under 35 U.S.C. 102(a) or (e).

This is the conclusion that the Examiner came to in the present Office Action, p. 2-3. However, the Applicants point to the below passage that follows Example 2 in § 716.10 of the MPEP:

In the situation described in Example 2, an affidavit under 37 CFR 1.132 may be submitted to show that the relevant portions of the reference originated with or were obtained from applicant. Thus the affidavit attempts to convert the fact situation from that described in Example 2 to the situation described in Example 1.

Id. Thus per the instructions above, Applicants submitted such a declaration in the following manner:

In response, Applicants have submitted herewith, as Attachment A hereto, a Declaration of Common Inventor pursuant to 37 C.F.R. 1.132 with regard to the Traut reference. In light of this Declaration, Applicants respectfully submit that the Traut reference does not disclose an invention "by another" and thus does not constitute prior art under 35 U.S.C. § 102(e), and Applicants respectfully request that these claims be allowed to issue.

Response to non-final action, dated December 22, 2004. Eric P. Traut declared that he was "the sole inventor of all the invention(s) (claimed and unclaimed) disclosed in U.S. Patent No. 6,651,132" (Declaration, p. 1). In other words, Eric P. Traut "attributed" the disclosure in the Traut patent to himself.

Rejection of Claims 1-20 Under § 102(e)

Notwithstanding the aforementioned "attribution," Applicants submit that claims 1-20 are patentable a fortiori, namely, that the Traut reference does not anticipate claims 1-20.

Claims 1, 10, and 17 are the independent claims. For example, claim 1 recites:

A method for emulating on a computer system the operation of a guest computer system, comprising the steps of:

providing an emulation program that runs as an application on the operating system of the host computer system, the emulation program emulating for at least one guest application program the operation of a guest operating system;

receiving at the emulation program blocks of software instructions from the guest application program; and

determining, for each block of instructions, whether (a) the block of instructions includes user level instructions, in which case the instructions are passed to the processor of the computer system for execution, or (b) the block of instructions include supervisor level instructions, in which case the block of instructions is translated and the translated block of instructions is passed to the processor of the computer system for execution.

(emphasis added). The last claim limitation is emphasized because Applicants submit that it cannot be found in the Traut patent.

Although in the present Office Action, dated May 13, 2005, the Examiner did not repeat the arguments made in the previous, non-final Office Action, dated October 21, 2004, in order to expedite the prosecution of this Application, the Applicants address the arguments made in the October 21, 2004 Office Action.

Regarding the claim 1 limitation emphasized above, the Examiner cited col. 4 line 17 and col. 4 line 15 of the Traut patent. *See* non-final Office Action, dated October 21, 2004, p. 3. The following is an excerpt from col. 4 ll. 14-18 encompassing the entire basis for the Examiner's rejection of the emphasize limitation of claim 1:

Other locations in memory may be accessed by system-level code in the guest operating system on read and write basis, while the same memory location may only be accessed by user-level code on a read-only basis.

(Traut, col. 4 ll. 14-18). While it is true that this passage mentions "system-level code" and "user-level code" in the context of memory access, the mere mention of these words does not teach "*determining, for each block of instructions, whether (a) the block of instructions includes **user level instructions**, in which case the instructions are **passed to the processor of the computer system for execution**, or (b) the block of instructions include **supervisor level***

instructions, in which case the block of instructions is translated and the translated block of instructions is passed to the processor of the computer system for execution” (claim 1)
(emphasis added).

Applicants remind the Examiner that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *See Also* MPEP § 2131. Here, it is simply not the case that Traut teaches in the passages cited by the Examiner “determining, for each block of instructions, whether (a) the block of instructions includes user level instructions, in which case the instructions are passed to the processor of the computer system for execution, or (b) the block of instructions include supervisor level instructions, in which case the block of instructions is translated and the translated block of instructions is passed to the processor of the computer system for execution” (claim 1).

Independent claims 10 and 17 recite similar limitations: “determining for each block of instructions whether the block includes supervisor level instructions, wherein each block of instructions that does not include a supervisor level instruction is passed to the processor of the host computer system, and wherein each block of instructions that includes a supervisor level instruction undergoes a translation step before being passed to the processor for execution” (claim 10); and “for those blocks of instructions that do not include supervisor level instructions, passing the block of instructions to the processor of the host computer system for execution; and for those blocks of instructions that include supervisor level instructions, translating the block of instructions before passing the translated block of instructions to the processor of the host computer system for execution.” (claim 17).

As mentioned, claims 1, 10, and 17 are the independent claims. Claims 2-9, 11-16, and 18-20 depend either directly or indirectly from claims 1, 10, and 17, respectively, and are believed allowable for the same reasons. Withdrawal of the rejection and allowability of the pending claims is thus earnestly solicited.

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PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116

CONCLUSION

Based on the Declaration submitted herewith, Applicants respectfully submit that the rejection of Claims 1-20 has been traversed and, accordingly, Applicants request that the rejections be withdrawn and that the claims be allowed to issue. Should the Examiner have any questions, comments, or suggestions that would expedite the prosecution of the present case to allowance, Applicants' undersigned representative earnestly requests a telephone conference at (206) 903-2461.

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